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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/640,437	08/17/2000	James Crouthamel	MBHB00-488	5131

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EXAMINER
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ZURITA, JAMES H

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 04/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/640,437

Applicant(s)

CROUTHAMEL ET AL.

Examiner

James H Zurita

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 35-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 August 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Prosecution History**

Applicant filed the present application on 17 August 2000 (paper # 1).

A First Office Action rejecting claims 1-34 was mailed 13 September 2002 (paper #6).

Applicant filed a request for reconsideration on 25 October 2002 (paper #7).

The request for reconsideration was rejected on 14 January 2003 (paper #8).

Applicant filed Amendment A on 19 March 2003 (paper #9). This amendment was not entered.

The Examiner sent out an Advisory Action on 27 March 2003 (paper #10).

Applicant filed a request for continuing examination (RCE) on 5 May 2003, along with preliminary amendment B (papers #13, #14).

The Examiner again rejected claims 1-34 on 3 July 2003 (paper #15).

Applicant filed amendment C on 9 September 2003 (paper #16), purporting to withdraw from consideration claims 1-34, and attempting to introduce new claims 35-52. Applicant's remarks were directed to the reference used to rejected claims 1-34.

The Examiner found Amendment C to be non-responsive to the rejection of claims 1-34 of 3 July 2003. However, the Examiner felt that Amendment C constituted a bona-fide, though flawed, attempt at a response, and so notified Applicant in a Letter of December 1, 2003 (paper #17). The Examiner's Restriction Requirement also explained that applicant's use of the term "...withdrawn..." creates an ambiguity as to the actual status of the claims.

Applicant filed Substitute Response to Office Action on December 2003 (paper #18), which failed to satisfy the requirements of Examiner's letter of 1 December 2003. Applicant's response contained the same errors as Amendment C. Applicant did not traverse the Restriction Requirement.

After several attempts to contact Applicant's attorney, Primary Examiner Smith spoke with Gary Jarosik on 15 April 2004. Mr. Jarosik acknowledged his erroneous attempt to **withdraw** claims 1-34 from consideration and agreed that he intended to **cancel** claims 1-34. Mr. Jarosik was advised he must amend application consistent with his intent and to include in any amendment a complete listing and status of all claims, as required under 37 C.F.R. 1.121.

The present Office Action is a response to paper 18. By the present Office Action, the Examiner vacates the Restriction Requirement of election by original presentation. Claims 1-34 are considered **cancelled**.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the LinkID must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

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***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 35, 38-41 and 43 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed method steps do not involve technology.

Claims 44-52 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. The claims, directed to computer medium, fail to mention a processor for executing computer instructions tangibly embedded in computer readable media.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 38-42 and 47-51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims refer to a link ID (LinkID in the specifications) and to a URL.

URLs are used by web browsers to locate Internet resources. A URL specifies the protocol to be used in accessing the resources, the name of the server on which the resource resides (such as *//www.whitehouse.gov*), and, *optionally, the path to a resource (such as an HTML document or a file on that server)*.<sup>1</sup> A URL may uniquely identify a specific file or image on a particular logical or physical server. The two URLs below point to two different files at the domain *sandybay.com*. The first specifies an executable file that should be fetched using the FTP protocol; the second specifies a Web page that should be fetched using the HTTP protocol:

<ftp://www.microsoft.com/stuff.exe>  
<http://www.pcwebpopedia.com/index.html><sup>2</sup>

It is not clear how a URL can lead to a merchant's web page and to a clearinghouse at the same time (see phrase "**via a clearinghouse site**" in claim 39).

Applicant's disclosures fail to clarify this point. See, for example, references to Table 3, LinkID, "closed loop" and "open loop" transaction methods.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 38-42 and 47-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims refer to a link ID and to a URL.

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<sup>1</sup> Definition of URL, Microsoft Computer Dictionary, *emphasis added*.

<sup>2</sup> Definition of URL, Computer & Internet Dictionary, Random House Webster's.

Consistent with the above definitions, the Examiner will interpret both link ID and URL as specifying a **single** destination.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 35-52** are rejected under 35 U.S.C. 103(a) as being unpatentable over Conklin et al. (US Patent 6,338,050).

**As per claims 35 and 44**, Conklin discloses media, methods and systems for exchanging product data among multiple parties, including a Sponsor (applicant's clearinghouse), Participants who may be sellers and buyers (applicant's merchants and partners). Conklin also discloses one or more Web Forms (applicant's first and second registration documents) whereby sellers and buyers may register to participate in exchanging product data. Conklin discloses that registration forms information is integrated into the system. See, for example, Fig. 25 and related text.

(a) **forwarding** from the clearinghouse site to a merchant site a first ... document. See, for example, references to registration forms, at least Fig. 1J and related text. See also at least Col. 2, lines 22-32. See also Fig. 1k and related text concerning filling out forms and templates.

(b) **receiving** at the clearinghouse site product data. See at least references to data extraction, uploading data, customizing web site, etc, Col. 20, lines 22-32, Col. 28, line 66-Col. 29, line 33.

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(c) **storing** product data received from the Participant-seller in a Sponsor database; see at least Col. 14, lines 1-29, Col. 30, lines 37-50.

(d) **receiving** at the clearinghouse site a second ... document. See, for example, references to formatting seller data for a buyer's system, at least Col. 33, line 47-Col. 34, line 10. The document and agreement received at the sponsor would include requests by a buyer to have data translated into a buyer's format. This information would be part of terms accepted by a seller as part of his agreement.

(e) **transmitting** from the clearinghouse site to the partner site product data. See at least Col. 3, line 62-Col. 4, line 17. See also at least Fig. 1n and related text for sponsor formats and transmission of data to participant.

***As per Claims 35-52, Conklin does not specifically disclose***

"(a) ...that specifies a database format for use by the merchant site in transmitting product data to the clearinghouse site;

(b) ... extracted from the merchant database, the extracted product data having been placed by the merchant site into database fields that comply with the database format specified in the first registration document;

(d) ...that specifies a database format for use by the clearinghouse site in transmitting product data to the partner site; and

(e) ...extracted from the clearinghouse database, the extracted product data having been placed by the clearinghouse site into database fields that comply with the database format specified in the second registration document whereby the product data is storable in the partner site database and thereafter made accessible for



providing a consumer visiting the partner site with information concerning merchant site product offerings.”

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The steps of (a) forwarding (b) receiving (c) storing (d) receiving (e) transmitting would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to (a) forward (b) receive (c) store (d) receive (e) transmit any type of data because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

The Examiner also notes that language of claims 35-52 include actions that are implied and inferentially recited but are not active steps in the claim's methods themselves.

***As per claims 36 and 45***, Conklin ***does not*** specifically disclose that one or more Web forms specify electronic delivery method and that the sponsor site receives product data via the specified electronic delivery method. See at least Col. 22, lines 25-51. See also discussion of existing systems, some system software may be installed at participant sites, may prefer to continue operating with a site's existing systems. At

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setup time, Sponsor and Participant-seller would specify how extracted data from a seller catalog would be uploaded to the sponsor site. See also Fig. 4A and 4B and related text, which disclose steps taken at Participant-seller registration process. See also references to TCP-IP, secure socket layers, HTTP. A participant would be able to receive information from a sponsor after specifying delivery methods.

**As per claims 37 and 46**, Conklin **does not** specifically disclose that one or more Web forms specify an electronic delivery method and that the sponsor site transmits product data via the specified delivery method. See at least Col. 22, lines 25-51, including discussion of existing systems, some system software may be installed at participant sites, may prefer to continue operating with a site's existing systems. See also Fig. 7-9 and related text, which disclose steps taken at Participant-buyer process. See also references to TCP-IP, secure socket layers, HTTP. A participant would be able to receive information from a sponsor after specifying delivery methods.

The following discussion relates to **claims 38-42 and 47-51**.

Conklin discloses the use of Web pages, HTML, URLs and direct and indirect links. For URLs, see at least Col. 2, lines 32-43, Col. 22, line 57-Col. 23, line 18, Col. 28, lines 52-65. Conklin discloses Fig. 2a, that merchants provide links for transactions. See, for example, at least Col. 3, lines 52-63, Col. 28, lines 52-65, Col. 11, line 60-Col. 12, line 13, Col. 25, line 54-Col. 26, line 10, Col. 29, line 43-Col. 30, line 16.

As per **claims 38 and 47**, Conklin discloses URL/link ID which correlates the partner site to the merchant site from which the product data was originally extracted.

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For example, see at least Col. 29, line 43-Col. 30, line 16, Col. 31, line 58-Col. 32, line 15, Col. 32, lines 16-55.

As per **claims 39 and 48**, Conklin discloses transmitting from the clearinghouse site to the partner site URL/Link ID that leads, through a sponsor site (e.g., a redirect mechanism). See at least Col. 29, line 43-Col. 30, line 16, Col. 31, line 58-Col. 32, line 15, Col. 32, lines 16-55 for references to direct and indirect links) to a web page maintained by the merchant site.

As per **claims 40 and 49**, Conklin discloses that the URL is a link ID. For example, see at least Col. 29, line 43-Col. 30, line 16, Col. 31, line 58-Col. 32, line 15, Col. 32, lines 16-55.

As per **claims 41 and 50**, Conklin discloses that the URL/Link ID leads to an order entry Web page maintained by the merchant site. See at least Col. 29, line 43-Col. 30, line 16, Col. 31, line 58-Col. 32, line 15, Col. 32, lines 16-55.

**As per claims 42 and 51**, Conklin **does not** use the word “cookie” and does not specifically disclose transmitting a cookie from a sponsor to a computer operated by a consumer in response to a consumer activating the URL. The use of cookies is notoriously well known. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Conklin and knowledge generally available to one of ordinary skill to disclose transmitting a cookie from a sponsor to a consumer computer.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Conklin and knowledge generally available to one of

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ordinary skill to disclose transmitting a cookie from a sponsor to a consumer computer for the obvious reason that Conklin tracks activity of its users. By placing a cookie of a customer's computer, Conklin can uniquely identify each customer as the customer views a participant's products.

**As per claims 43 and 52**, Conklin **does not** specifically disclose that the web forms are forwarded from a clearinghouse to a merchant in response to a request to create an account for the merchant site at the clearinghouse site. See, for example, references to completion of registration process, Fig. 4A and related text.

### ***Response to Amendment***

Applicant's statement of the status of claims 1-34 is incorrect. As per interview with Applicant's representative, claims 1-34 are considered cancelled.

Claims 35-52 are pending and will be examined.

The Examiner will address applicant's arguments of 22 December 2003 as being directed to claims 35-52.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-34 have been considered but are moot in view of the new ground(s) of rejection.

A "traverse" is a denial of an opposing party's allegations of fact.<sup>3</sup> The Examiner respectfully submits that applicants' arguments and comments do not

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<sup>3</sup> Definition of Traverse, Black's Law Dictionary, "In common law pleading, a traverse signifies a denial."

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appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made. Even if one were to interpret applicants' arguments and comments as constituting a traverse, applicants' arguments and comments do not appear to constitute an adequate traverse because applicant has not specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a). An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. In re Boon, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA1971).

If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). MPEP 2144.03  
Reliance on Common Knowledge in the Art or "Well Known" Prior Art.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

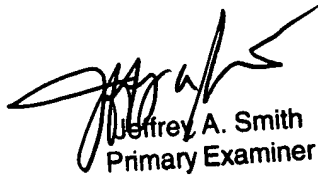
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Zurita whose telephone number is 703-605-4966. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

)<sup>t</sup>  
**James Zurita**  
**Patent Examiner**  
**Art Unit 3625**  
20 April 2004

  
Jeffrey A. Smith  
Primary Examiner